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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,139	12/06/2000	Christiane Guitard	4-31268A	8688

1095 7590 01/24/2003

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EXAMINER

WEDDINGTON, KEVIN E

ART UNIT PAPER NUMBER

1614

DATE MAILED: 01/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/731,139

Applicant(s)

Guitard et al.

Examiner
Kevin E. Weddington

Art Unit
1614



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 8, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5, 6, 8, 9, and 11 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 8, and 11 is/are rejected.
- 7) ☒ Claim(s) 6 and 9 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other:

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Claims 1, 2, 5, 6, 8, 9 and 11 are presented for examination.

Applicants' amendment filed November 8, 2002 has been received and entered.

Accordingly, the rejections made under 35 U.S.C. 112, first paragraph and second paragraph as set forth in the previous Office action at pages 2 and 3 are hereby withdrawn. The allowance of claims 1, 2 and 6 will be removed so that a new rejection can be made.

Claim Objections

Claim 6 is objected to because the cited reference does not teach the claim limitation.

Claim 9 is objected to because the cited reference does not teach the preferred hypoglycemic agent is nateglinide, but the claim would be allowable if applicants rewrites the claim by combining claims 1 and 8 together.

Claim Rejections - 35 U.S.C. § 112

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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Applicants' specification does not contain any test results or experimental data using the other hypoglycemic agents of claim 8. Applicants only discloses test results for the hypoglycemic agent, nateglinide.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Li et al. (R).

Li et al. teach the effect of metformin, a hypoglycemic agent, on glucose metabolism, insulin sensitivity and conversion rate of diabetes mellitus in IGT patients. The cited reference showed that 28 IGT patients were treated with metformin and became normal after one-year of treatment. Clearly, the cited reference teaches a hypoglycemic agent is known to treat conditions and diseases associated with IGT. Clearly, the cited reference anticipates the applicants' instant invention, therefore, the applicants' instant invention is unpatentable.

Claim 1 is not allowed.

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Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. (R).


Li et al. was discussed above supra for its use of a hypoglycemic agent, metformin, is used to treat conditions and diseases associated with IGT.

The instant invention differs from the cited reference in that the cited reference does not teach the other conditions disclosed in claim 2, 5 and 11 are treated by the administration of the a hypoglycemic agent. However, one skilled in the art would have been motivated to administer a hypoglycemic agent to treat the said conditions of claims 2, 5 and 11 since the hypoglycemic agent is well-known to treat the conditions associated with IGT, then inherently all other conditions such as diabetes and its complications will be treated in the absence of evidence to the contrary.

Claims 2, 5 and 11 are not allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner K. Weddington whose telephone number is (703) 308-1235.


Kevin E. Weddington
Primary Examiner
Art Unit 1614

K. Weddington

January 22, 2003